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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,148	10/14/2003	Minoru Kawahara	450100-04787	4785

7590 09/18/2008  
FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK, NY 10151

EXAMINER
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SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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09/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/685,148	<b>Applicant(s)</b> KAWAHARA, MINORU	
	<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 8,10,18,20,28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-17,19,21-27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/04/2008 has been entered.

***Response to Amendment***

2. The amendments, filed 07/01/2008, have been entered and made of record. Claims 1-7, 11-17, 19, 21-27 and 29 are pending. Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non elected species. The elected was made in the reply filed on 07/19/2007. Please indicate withdrawal of claim 8 in the listing of claims.

***Response to Arguments***

3. Applicant's arguments filed 07/01/2008 have been fully considered but they are not persuasive.

Applicant states "there is no suggestion the controller 2 of Ishige is performing function recited in claim 1." In response the Examiner respectfully disagrees. Claim 1 does not recite that a controller performing the function of claim 1.

Applicant states the cited prior arts either in combination or alone fail to teach claim 1. In response the Examiner respectfully disagrees. Ishige discloses materials are edited so that they may fall within a predetermined broadcasting time. The predetermined broadcasting time has a start and end of the specific program. Furthermore Ishige discloses when the storage medium 4 is

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brought into the broadcasting station, the encoded data of high resolution is broadcast in accordance with EDL. the EDL determines the start and end of a clip.

In the same field of endeavor Kellner discloses a seek operation to access data stream 9see figures 2-11b). Kellner further teaches a set of stream B element is located immediately after a set of stream A.

Therefore the cited prior arts teaches the claimed invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9, 11-17, and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Ishige (US PG PUB 2002/0057894 A1) in view of Kellner (WO 94/03851).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Ishige discloses a data processing apparatus comprising: a detector for detecting completion of preparations (editing) for outputting first data read from a data recording medium which stores said first data and second data corresponding to said first data and having a data amount smaller than that of said first data (see fig. 1 where it shows encoders of low and high resolution data and claim 1 and paragraphs 0025-0029); wherein said first data are made up of a continuous collection of clips, said first data being reproduced on a clip by clip basis, said data processing apparatus further comprising: a position calculator for calculating a current clip read ending position and a next clip read starting position, said current clip read ending position being the position in which to end reading of the currently reproduced clip from said data recording medium, said next clip read starting position being the position from which to start reading from said data recording medium the clip to be reproduced next following the current clip; and wherein said reader stops reading of the current clip from said data recording medium in said current clip read ending position and starts the reading of the next clip from said next clip read starting position (see paragraphs 0041-0044 and claims 1-9; see also the response above); and a selector for selectively outputting said second data read from said data recording medium until the completion of said preparations for outputting said first data is detected, said selector further outputting selectively said first data once the completion of said preparations for outputting said first data is detected (see paragraphs 0037-0044).

Claim 1 differs from Ishige in that the claim further requires a ready flag that denotes a status of the preparations.

In the same field of endeavor Kellner discloses a ready flag that denotes a status of the preparations (see page 5 paragraph 3 and page 6 paragraph 2, if, while the system is reading elements, the buffer becomes full, this is detected in step 208 and the reading process pauses). Therefore in light of the teaching in Kellner it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishige by providing a status indicator in order to place all the data in the buffer.

Regarding claim 2, Ishige discloses a first controller for controlling reproduction of said first data; and a second controller for controlling reproduction of said second data; wherein said first controller controls the reproduction of said first data in response to the reproduction of said second data controlled by said second controller (see fig. 1 and paragraphs 0027-0028).

Regarding claim 3, Ishige discloses first data and said second data corresponding to said first data are stored intermittently on said data recording medium (see paragraphs 0036 and 0041).

Regarding claim 4, Ishigie discloses first data are video data and said second data are video data obtained by lowering resolution of the video data constituting said first data (see abstract).

Regarding claim 5, Ishige discloses a resizer for resizing the video data constituting said second data into the same size as that of said first data (see paragraphs 0026-0028).

Regarding claim 6, Ishige discloses a decoder for decoding said first data furnished as encoded data; wherein said detector detects completion of preparations for outputting results of the decoding performed by said decoder (see paragraphs 0041-0044).

Regarding claim 7, Ishige discloses a reader for reading said first data and said second data from said data recording medium (see fig. 1 components 3 and 4).

Regarding claim 9, Ishige discloses reader stops reading of the current clip from said data recording medium in said current clip read ending position and starts the reading of the next clip from said next clip read starting position (see paragraphs 0042-0043 and the response above).

Method claims 11-17 and 19 are rejected for the same reasons as discussed in claims 1-7 and 9 above.

6. Claims 21-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishige in view of Kellner and further in view of Official Notice.

Regarding claim 21-27 and 29, the limitations in claims 21-27 and 29 can be found in the apparatus claim 1-7 and 9 respectively. However claims 21-27 and 29 further require a program to perform steps as claimed in claims 1-7 and 9. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Ishige and Kellner by having a software program to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

### ***Conclusion***

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
September 12, 2008

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621